

REMARKS

Applicant respectfully requests reconsideration of the subject application for the reasons set forth herein.

Telephonic Interview with Examiner

Applicant respectfully thanks the Examiner for conducting an interview over the telephone with Applicant regarding this Application subsequent to issuing a final Office Action. In the interview, Applicant and the Examiner discussed the claims of the present invention and the final Office Action in order to more clearly understand the rejection made therein and also to more clearly point out the distinguishing characteristics in the present invention as set forth in the present Application which make it patentable. Applicant has shaped these Remarks made herein in light of the discussions carried out during the telephonic interview.

Amendment After Final

Entry of this amendment is respectfully requested on the ground that this amendment places the application in condition for allowance. Alternatively, entry of this amendment is respectfully requested on the ground that this amendment places the claims in better form and condition for appeal. Furthermore, Applicant submits that any changes made to the claims herein do not require an additional search on the part of the Office, nor do any amendments made herein raise new issues with regard to the patentability of the claims now pending.

Nonstatutory Double Patenting

Claims 37-38 and 54-73 stand rejected on the ground of nonstatutory obviousness-type double patenting over Claims 1-51 of U.S. Patent No. 6,959,183 (the “183 Patent”). Applicant respectfully traverses these rejections for at least the following reasons.

The M.P.E.P. § 804 recites, in part:

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 U.S.P.Q.2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 U.S.P.Q.2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 U.S.P.Q. 761 (C.C.P.A. 1982); *In re Vogel*, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970); and *In re Thorington*, 418 F.2d 528, 163 U.S.P.Q. 644 (C.C.P.A. 1969).

Furthermore, an obviousness-type double patenting rejection is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. § 103." *In re Braithwaite*, 379 F.2d 594 (C.C.P.A. 1967); M.P.E.P. § 804. Thus, any analysis employed in an obviousness-type double patenting rejection is basically the same as the analysis employed for a 35 U.S.C. § 103 obviousness determination. *In re Braat*, 937 F.2d 589 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887 (Fed. Cir. 1985); M.P.E.P. § 804.

In a usual obviousness analysis, the holding in *In re Vaeck* applies and, in light of the above discussion, *In re Vaeck* thus applies in an obviousness-type double patenting analysis. In *In re Vaeck*, the court held that, to establish a prima facie case of obviousness, three basic criteria must be met. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference must teach or suggest all claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must not be based on an applicant's disclosure. *Id.*

Because *In re Vaeck* is such a case that defines the analysis required for a 35 U.S.C. § 103 obviousness rejection, it follows, as discussed above, that it also defines the analysis required for an obviousness-type double patenting rejection. In addition, M.P.E.P. § 804, further recites the factual inquiry to be undertaken in a concluding whether an obviousness-type double patenting rejection is warranted, which involves:

- (A) Determin[ing] the scope and content of a patent claim [] relative to a claim in the application at issue;
- (B) Determin[ing] the differences between the scope and content of the patent claim [] as determined in (A) and the claim in the application at issue;
- (C) Determin[ing] the level of ordinary skill in the pertinent art; and
- (D) Evaluat[ing] any objective indicia of nonobviousness.

M.P.E.P. § 804. Furthermore, any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim [] at issue would have been [] an obvious variation of the invention defined in a claim in the patent.

M.P.E.P. § 804.

Thus, the obviousness-type double patenting rejection currently standing on Claims 37-38 and 54-73 must meet the criteria specified under *In re Vaeck* and the relevant section in the M.P.E.P.

The Claims of the ‘183 Patent Do Not Make Applicant’s Invention Obvious

Independent Claims 37, 38, 54, and 64 disclose methods of providing wireless communications services “comprising...targeting a design of the services to the user primarily from limited geographic areas in which the user lives, works, and plays...” Applicant respectfully asserts that these Claims are made not obvious by the ‘183 Patent’s claims.

The Office Action states that Claim 1 of the ‘183 Patent which claims, in part, “a limited geographic region that approximates at least one municipal region” makes obvious the claims of the present invention which disclose “limited geographic areas in which the user lives, works, and plays.” *Office Action of April 3, 2006*, at 2-3. Applicant respectfully asserts that the ‘183 Patent does not claim a “limited geographic area[] in which the user lives, works, and plays.” The ‘183 Patent claims a limited geographic area that approximates *at least one municipal region*. However, areas in which a person *lives, works, and plays* is distinct from *at least one municipal region* because the former denotes areas that *may not be* municipal regions, such as rural, remote, and/or non-municipal areas, as well as multiple municipal regions. Areas where a person lives, works, and plays include areas outside of a municipal region, and, at the same time, also represent areas that are more defined and specific to a person’s living habits than one or more mere municipal regions. Thus, the two represent exclusive and discrete concepts. Because the present invention’s claims of areas where a person “lives, works, and plays” has a much more exclusive, discrete, specific, and defined meaning than that of areas of “*at least one municipal*

region” claimed in the ‘183 Patent, the ‘183 Patent does claim each and every element of the present invention’s claims. Because the ‘183 Patent’s claims and the present invention’s claims may be exclusive and discrete concepts, the ‘183 Patent has a distinct claim coverage, as does the present invention. The ‘183 Patent’s claims and the present invention’s claims are not only different in language and construction, but are also different in scope and meaning. Thus, Applicant respectfully asserts that Claims 37, 38, 54, and 64 of the present invention are not obvious over Claims 1 and 2 of the ‘183 Patent and, therefore, the present invention is patentable over the ‘183 Patent in this regard.

In addition, Applicant respectfully asserts that the obviousness of the claims of Applicant’s invention over the claims of the ‘183 Patent is not shown in order to substantiate the nonstatutory obviousness-type double patenting rejection. Except for the statements that the present invention is “not patentably distinct” from the claims of the ‘183 Patent, nothing more is set forth describing the reasons why the claims of Applicant’s invention are obvious over the claims of the ‘183 patent. *See Office Action of April 3, 2006*, at 3-4. Applicant respectfully submits that the Office Action has failed to set forth the necessary support or evidence of how the wording variations between Applicant’s presently claimed invention and the ‘183 Patent’s claims rise to the level of making Applicant’s claimed invention obvious over the ‘183 Patent’s claims, as required in M.P.E.P. § 804. Applicant respectfully submits that the Office Action merely states that Applicant’s invention is not patentably distinct from the ‘183 Patent despite “obvious wording variations.” *Office Action of April 3, 2006*, at 2. However, these wording variations are that which Applicant respectfully asserts makes this claimed invention not obvious over the ‘183 Patent’s claims. Because the Office Action has failed to set forth any evidence of the requisite elements of obviousness under *In re Vaeck* and M.P.E.P. § 804, Applicant

respectfully asserts that Applicant's claimed invention is not obvious over the claims of the '183 Patent.

Accordingly, Applicant submits at least Claims 37, 38, 54, and 64 are patentably distinguishable over the claims of the '183 Patent. Applicant further submits that Claims 55-63 and 66-73 are similarly distinguishable over the claims of the '183 Patent by virtue of their ultimate dependency from patentably distinct base claims.

Conclusion

Wherefore, Applicant respectfully believes all outstanding grounds raised by the Examiner have been addressed, and thus respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited.

Respectfully Submitted,

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